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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/838,348	04/19/2001	Randall W. Ojanen	K-1786	2490

7590 06/06/2005

Kennametal Inc.
P.O. Box 231
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EXAMINER	
SINGH, SUNIL	
ART UNIT	PAPER NUMBER
3673	

DATE MAILED: 06/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/838,348	OJANEN, RANDALL W.	
	Examiner	Art Unit	
	Sunil Singh	3673	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *15-17,29,30,32-34,36-40 and 43-47* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *15-17,29,30,32-34,36-40 and 43-47* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☒ Other: attached 1 drawing sheet.

5.00

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 15-17, 29-30, ~~32-40~~ 32-34, 36-40, 43-47 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant in the specification pages 10-11 explicitly states that the prior art in particular Emmerich '783 and Engle et al. '309 both teach protruding surfaces that are spring loaded so as to expand into the notch of a bore. Page 11 goes on to state that debris and dirt interferes with the inward radial play of the radial protruding surfaces making the tools very difficult and sometimes impossible to remove. Applicant then states that his protruding dimples are designed to require **no radial play**. It is the examiner's position that such a statement of the protruding dimples not requiring radial play is incorrect. In order for the sleeve (40) with dimples (46) to be inserted into bore 20 and then have the dimples snap into notch 38 there **must be some radial play. Such radial play might not be to the extent of the prior art; nevertheless there must be some radial play; otherwise, the sleeve would be an interference fit with the bore and this is clearly not the case because the sleeve has slit (42). For example look at Figure 12, in order for dimple (46) to snap into**

notch (38) it would have to pass through a narrower inner sleeve diameter prior to getting to the notch therefore there must be some degree of radial play. Based on these discrepancies, one skilled in the art cannot make and/or use the invention as claimed.

If applicant wants to rely on there is "no radial play" required in the removal of the tool; then applicant needs to cite where in the original disclosure is there basis for the removal of the retainer sleeve without excessive force that does not require inward radial play. As a matter of fact, this further emphasizes the enablement rejection. One skilled in the art would not know how to remove the retainer sleeve from the bore without excessive force in an alternative mode (meaning one without radial play) without undue experimentation.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 15-17, 29-30, ~~32-40~~ 32-34, 36-40 43-47 rejected under 35 U.S.C. 102(e) as being anticipated by Sollami (US 6397652).

Sollami discloses a cutting tool assembly, said assembly comprising:

a cutting tool (10") a retainer sleeve (38") carried by the cutting tool, and including at least one radially outward protruding surface (31); wherein said retainer has a cylindrical circumference and a thickness dimension, the amount of radial projection of said protruding surface beyond the cylindrical surface of the retainer is between about 15 percent and about 30 percent of the thickness dimension of said retainer (see attached marked up Fig. 15).

Response to Arguments

5. Applicant's arguments filed in the last response have been fully considered but they are not persuasive. Applicant states that the dimples "require no radial play" in plain and simple meaning is not that there may not be any radial play of the dimples upon removal of tool, but only that radial play is not a requirement for removal of the tool". Then if this is the case, the specification does not enable one skilled in the art to

remove the retainer sleeve from the bore without excessive force in an alternative mode (meaning one without radial play) without undue experimentation.

Applicant argues that "inward radial play" is not a requirement to remove the tool since the dimples only project between about 15 to 30 percent of the thickness dimension of the retainer. This further, emphasizes the enablement rejection. One skilled in the art would not know how to remove the retainer sleeve from the bore without excessive force in an alternative mode (meaning one without radial play) without undue experimentation.

It is the examiner's position that such a statement of the protruding dimples not requiring radial play is incorrect. In order for the sleeve (40) with dimples (46) to be inserted into bore 20 and then have the dimples snap into notch 38 there **must be some radial play. Such radial play might not be to the extent of the prior art; nevertheless there must be some radial play; otherwise, the sleeve would be an interference fit with the bore and this is clearly not the case because the sleeve has slit (42). For example look at Figure 12, in order for dimple (46) to snap into notch (38) it would have to pass through a narrower inner sleeve diameter prior to getting to the notch therefore there must be some degree of radial play.**

If applicant wants to rely on there is "no radial play" required in the removal of the tool; then applicant needs to cite where in the original disclosure is there basis for the removal of the retainer sleeve without excessive force that does not require inward radial play. As a matter of fact, this further emphasizes the enablement rejection. One skilled in the art would not know how to remove the retainer

sleeve from the bore without excessive force in an alternative mode (meaning one without radial play) without undue experimentation.

On page 8 of applicant's remark section, applicant points to page 12 lines 15-21, wherein the specification implies radial movement; however, this contradicts page 11 lines 14-17, wherein "no radial play" is recited; therefore, one skilled in the art cannot make and/or use the invention as claimed.

Applicant argues that Sollami '652 does not show the dimension of the dimples as called for in the claims. The examiner disagrees and would like to direct applicant to attach marked up Figure 15, wherein the dimension of the dimples being about 15 to 30 percent the thickness of the retainer is clearly met.

Conclusion

6. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sunil Singh whose telephone number is (703) 308-4024. The examiner can normally be reached on Monday through Friday 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Shackelford can be reached on (703) 308-2978. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sunil Singh
Primary Examiner
Art Unit 3673

SS

5/25/05

Fig. 14

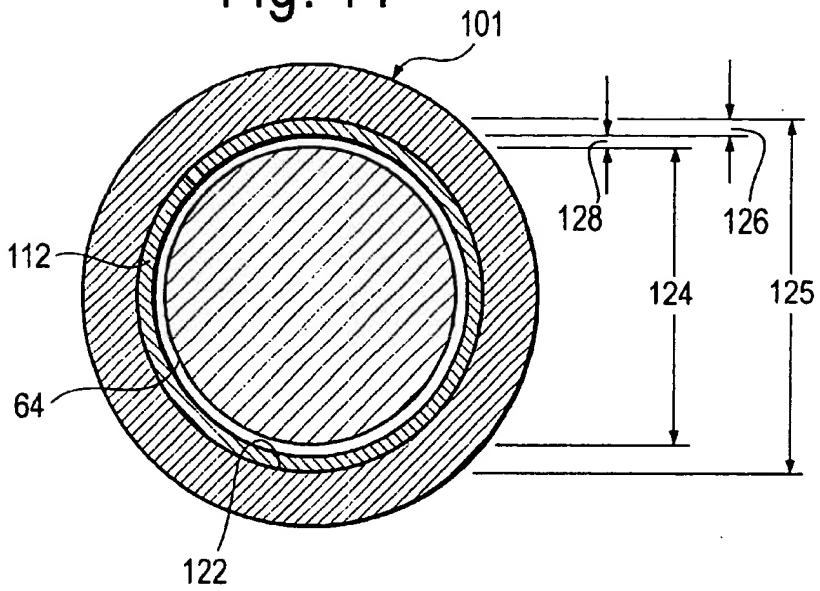
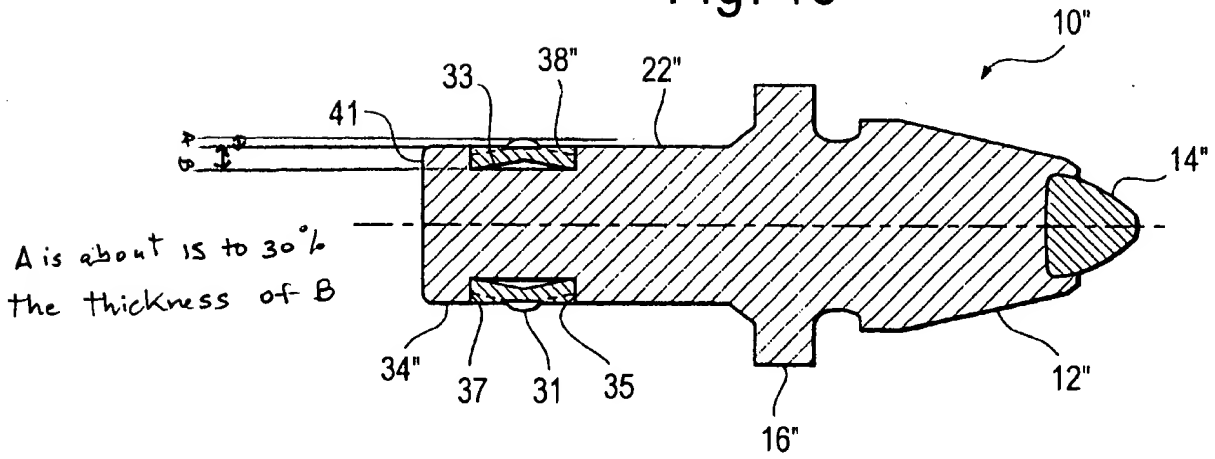

101
128
126
112
124
125
64
122

Fig. 15


10"
33
38"
22"
41
14"
A is about 15 to 30% the thickness of B
34"
37
31
35
16"
12"